



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/826,906

04/16/2004

Asil T. Gokcebay

439RE

2239

7590

12/07/2004

Thomas M. Freiburger
P.O. Box 1026
Tiburon, CA 94920

EXAMINER

HOLLOWAY III, EDWIN C

ART UNIT

PAPER NUMBER

2635

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/826,906

Applicant(s)

GOKCEBAY ET AL.

Examiner

Edwin C. Holloway, III

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

EXAMINER'S RESPONSE

1. In response to the reissue 4-16-04, the application has been examined. The examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Reissue Applications

2. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 6552650 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

Original Patent Required

3. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.78.

Art Unit: 2635

Recapture Rejection

4. Claims 16-18 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claim 16 corresponds to original claim 5 with, among other things, removing from the claims 5 the following language:

(e) microprocessor means in the key head, powered by the battery, and data storage means in the key head connected to the microprocessor means,

Art Unit: 2635

(f) the battery being connected to power the microprocessor means and data storage means, and

(g) the microprocessor means and data storage means having means for reading an electronic ID code of a lock when the one-wire bus connection is made, and for looking up the read ID code in the data storage means and for making a yes or no decision, based on the content of the data storage means, as to whether the lock is authorized to be opened, and if so, for sending a prescribed data signal to the lock electronics and power from the battery to the lock's blocking device, to allow opening of the lock.

Claim 16 replaces the above language with the following:

(e) means for communication between the lock electronics of the lock cylinder and the electronics of the key head when the key blade is inserted into the lock cylinder to determine whether the lock is authorized to be opened, and if so, for sending power from the battery to the lock's blocking device, to allow opening of the lock.

This amendment was made to remove the microprocessor means, data storage means and decision in the key head as indicated by the reissue declaration stating that the claims are unnecessarily restrictive in regard to location of a microprocessor and data storage and where the decision is made as to whether or not access is to be granted. Independent claims 5 is unnecessarily limited in this manner, and additional claims are now submitted that are not thus limited.

This is improper recapture because applicant's 10-15-98 amendment in the patent application amended claim 5 to add the "in the key head" limitation to the microprocessor means and the data storage means. It is also noted that microprocessor means

Art Unit: 2635

and data storage means in claim 5 include the means for making a decision. Further, applicant's arguments on page 6 lines 13-17 of this amendment argued that "Hyatt clearly teaches away from self containing power source, a microprocessor and database within a mechanical key head, and making decisions as to access or no access of any of a series of locks directly in the key head." Additionally, page 7 lines 10-13 of the amendment argued "Importantly, Gelhard's microprocessor does not make comparisons and access (yes or no) decisions, as does the microprocessor in the key head of the present invention."

New claim 16 also lacks the "one-wire-bus" of original claim 5. This is improper recapture because the paragraph bridging pages 7-8 of the 10-15-98 amendment argues that "Gelhard does not have a one-wire-bus connection, underscoring the concern of this reference with a type of contactless electrical connection and detracting from its teaching in the direction of the invention."

Defective Declaration

5. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Art Unit: 2635

The error identified by applicant is directed to recapture. Therefore, the identified error is not an appropriate error.

6. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The declaration must state whether the inventor is a sole or joint inventor of the invention claimed as required by 37 CFR 1.63(a)(4). Page 1 of declaration states "sole" inventor, but lists two inventors. This does not comply with rule 63(a)(4).

7. Claims 1-18 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a),

Art Unit: 2635

the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aston (US 5351042) in combination with Clark (US 4829296). Aston discloses a key with blade having mechanical bitting, wherein battery and electronics in the key head send power and data to operate a cylinder lock. See col. 2 line 60 - col. 27 figs. 3-4. Aston differs from the claims by not specifying decision made in the key. Clark discloses an analogous art lock system with microprocessor in an access device that operates as a key to provide data and power to a lock. See col. 2 line 32 - col. 3 line 8. This prevents systematic theft in col. 3 lines 28-35. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the decision of Clark in the key of Aston in order to prevent systematic theft. Regarding claim 17, Clark specifies a microprocessor 120 in col. 5 line 3. Regarding claim 18, Clark specifies a series of access codes in col. 2 lines 35-38.

Art Unit: 2635

CONTACT INFORMATION


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at ebc@uspto.gov. The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.

Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600.

Facsimile submissions may be sent via fax number (703) 872-9306 to customer service for entry by technical support staff. Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068.

EH
11/29/04


EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
ART UNIT 2635